

REMARKS

The application has been amended to place the application in condition for allowance at the time of the next Official Action.

The specification is amended to make editorial changes therein.

Claims 8-15 are pending in the application.

Claims 8-15 were rejected under 35 USC §103(a) as being unpatentable over BALLARD et al. 5,377,281 in view of JOST et al. 7,043,439. That rejection is respectfully traversed.

Independent claim 8 recites calculating the smallest possible length difference corresponding to each distance that indicates how much the length of the remaining part of the input symbol string not examined in the distance calculation differs from the lengths remaining in the symbols strings passing through the calculation point and calculating on the basis of each distance and corresponding length difference a reference value.

The Official Action recognizes that BALLARD fails to teach calculating the smallest possible length difference between symbols in a string. JOST is offered for this teaching with the Official Action concluding that it would have been obvious to combine BALLARD and JOST to render obvious this feature.

However, this position is believed to be untenable for at least the following reasons.

First, the Federal Circuit has held that it is improper to combine references when the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Column 8, lines 60-66 of BALLARD disclose the use of both valid English words and invalid words when "growing" a path. Such growth does not qualify as a result of a symbol string search. Rather, such growth search teaches away from a length comparison and it would be opposed to the teachings of BALLARD to carry out a calculation of the length difference as recited.

Accordingly, it would be improper to combine BALLARD with any reference that discloses length difference calculations.

Second, even if one were to consider BALLARD and JOST in the first instance, JOST does not disclose that which is recited.

Column 17, lines 18-32 and column 19, lines 39-46 and Figure 8 of JOST, offered in the Official Action, fail to teach or suggest using a length difference calculation.

Rather, these passages disclose organizing records (questions) in a hierarchical trie structure and the use of the path length of the structure in selecting questions. However, no length difference calculation is involved using an input symbol string as recited.

Instead, a length difference calculation in JOST is impossible (and therefore could not be disclosed). JOST does not

have an input symbol string that could be used in length difference calculations and consequently, the length of such a hypothetical input symbol string is unknown and not available for length difference calculation. Rather, JOST is only interested in finding the shortest path to a record, in other words, to minimize the number of questions that need to be presented. See column 17, lines 18-32. JOST does not compare the length of available paths to the remaining length of any input symbol string.

Thus, even if one of ordinary skill in the art were to consider the combination of BALLARD and JOST in the first instance, the proposed combination does not provide a solution involving length difference calculation as neither of these references teaches or suggests that the length of the input symbol string should or could be compared with the remaining lengths of the symbol string in a trie data structure.

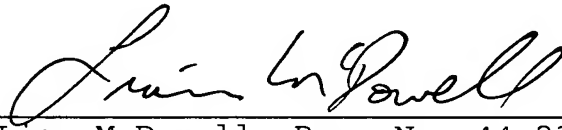
Accordingly, the proposed combination of references would not have been sufficient to render the claims *prima facie* obvious.

In view of the present amendment and the foregoing remarks, it is believed that the present application has been placed in condition for allowance. Reconsideration and allowance are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON

A handwritten signature in cursive script, reading "Liam McDowell", written in black ink.

Liam McDowell, Reg. No. 44,231
745 South 23rd Street
Arlington, VA 22202
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709

LM/lrs